

## REMARKS

In view of the following remarks, Applicant respectfully requests  
5 reconsideration and allowance of the subject application. This Response is believed to be fully responsive to all issues raised in the March 21, 2011 Final Office Action. Claims 10 and 24 are currently amended to address objections. Claims 1-29 are pending.

### 10 Brief Comment on Office's Response to Arguments

At page 6 of the pending Office Action (item 7), the Office responds to Applicant's previously submitted arguments (communication of December 12, 2010) by stating:

15 As shown in Figures 2-3, Pelters et al. disclose a catalyst (4) which clearly has a cylindrical shaped body. Also as depicted in Figure 2, the catalyst body in Pelters et al. is held by a cradle (25) having at least a plate. Thus, Pelters et al. clearly disclose the claimed limitations in dispute.

As argued below, Applicant contends that various inappropriate assumptions  
20 need to be made to conclude that independent claims 1 or 15 are anticipated by the Pelters reference. For example, to find that the bottom 25 of the catalyst 4 of Fig. 2 is a plate or wall, it appears that one must assume that the catalyst 4 of Fig. 2 is rectangular (see description at col. 2, lines 36-40). Further, it appears that one would need to assume that a wall, without more, is sufficient evidence of a cradle.

25 For at least the reasons that follow, Applicant respectfully submits that claims 1-13 and 15-28 are not anticipated by the Pelters reference and that claims 14 and 29 are not unpatentable over the Pelters reference.

### Rejections of the Claims under 35 USC § 102(b)

30 In the pending Office Action, the Office rejects claims 1-13 and 15-28 under 35 USC § 102(b) as being anticipated by Pelters et al. (US Patent No. 5,058,380).

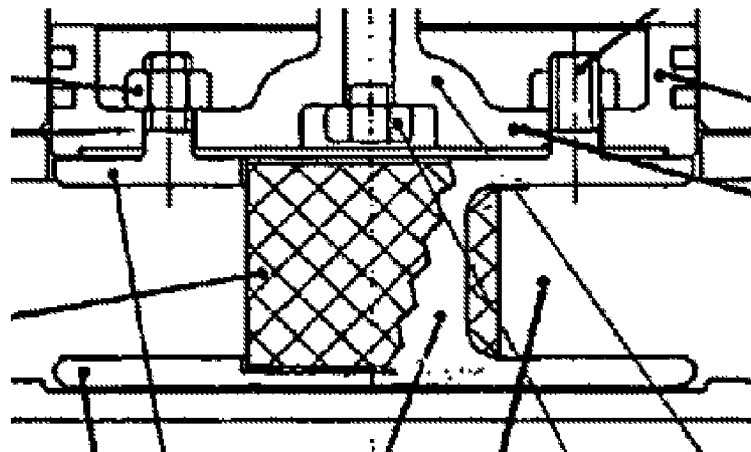
### *Standards*

Per MPEP § 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as  
5 is contained in the ... claim."

Per Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1296 (Fed. Cir. 2002): "The difference between a printer and a photocopier may be minimal and obvious to those of skill in this art. Nevertheless, obviousness is not inherent anticipation. Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir.  
10 1984) ('though anticipation is the epitome of obviousness, [they] are separate and distinct concepts').".

### *A Cradle: A Structure Having More than a Plate*

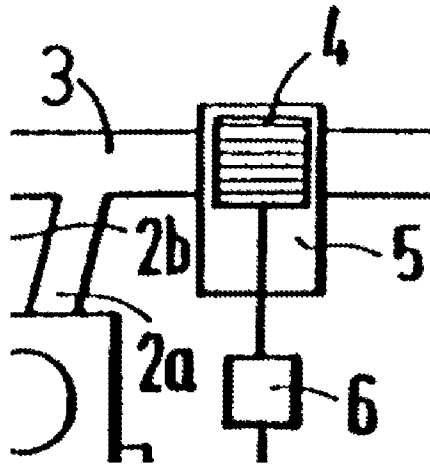
The pending claims recite "*said catalyst body (1) is held by a cradle (5)*". As  
15 stated in the instant application, as filed and at paragraph [0025] of the previously submitted substitute specification: "The plates 2, 3 are connected to each other via two thin walled posts 4 bended to match the curvature of the outer circumference of the plates 2, 3."



20 A portion of Fig. 1 of the instant application is reproduced above, for convenience, which illustrates the cradle 5 as having the plates 2, 3 and the posts 4. Applicant submits that the term "cradle" is known in the art to be something more than merely a plate or two unconnected plates.

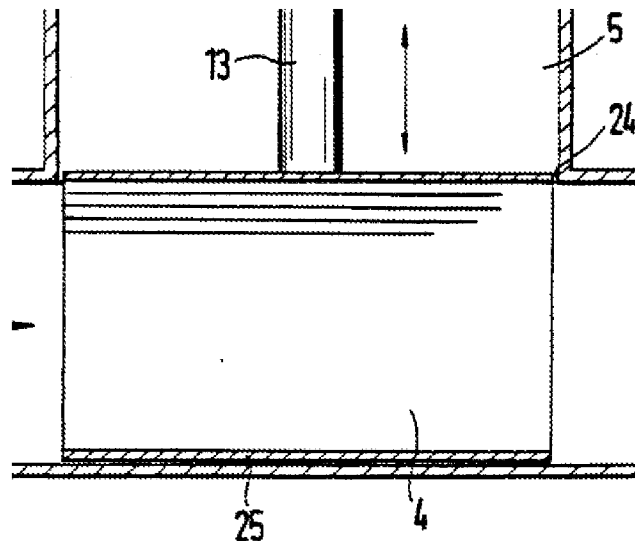
*Pelters Reference: Insufficient Evidence of a Cradle*

The Pelters reference is directed to a movable catalyst 4, which is shown in Figs. 1, 2, 3 and 4.



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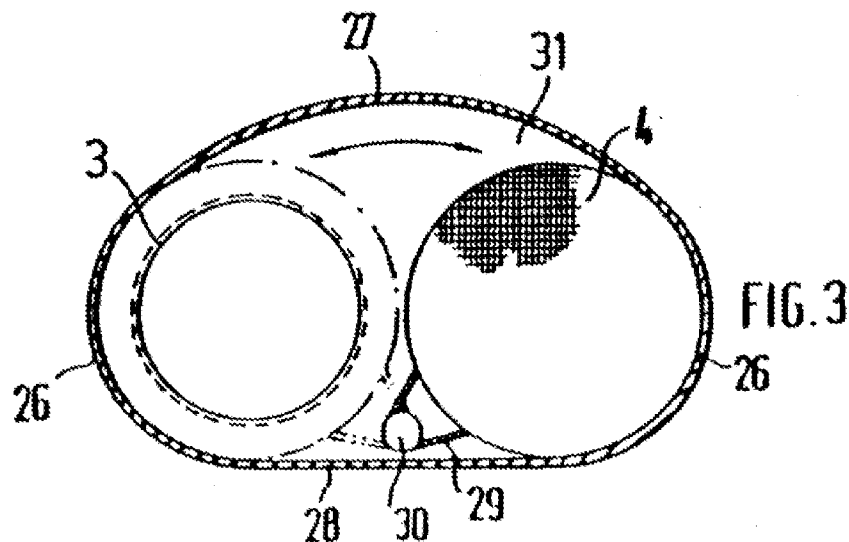
A portion of Fig. 1 is reproduced above, which shows the movable catalyst 4 attached to an adjusting device 6 for controlling entry and exiting of the catalyst from a lateral chamber 5 (col. 2, lines 1-5).



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A portion of Fig. 2 is reproduced above, which shows a "guide rod 13 fastened to the top of the catalyst 4" (col. 2, lines 18-19). As to reference numeral 25, it is explicitly "the bottom 25 of the catalyst 4" (col. 2, lines 36-37). As stated at col. 2, lines 15-17, the "catalyst 4 can be made of metal or ceramics and may be round or rectangular".

Based on the foregoing objective evidence of record, Applicant submits that the guide rod 13 is fastened directly to a metal or ceramic catalyst 4. In other words, Applicant finds no objective evidence as to a cradle in which the catalyst 4 is held.



5 Fig. 3 is reproduced above, which shows the cylindrical catalyst 4 where a “sheet metal bracket 29 is mounted on the outside of catalyst 4” (col. 2, lines 47-48). As stated at col. 2, lines 15-17, the “catalyst 4 can be made of metal or ceramics”.

Based on the foregoing objective evidence of record, Applicant submits that the sheet metal bracket 29 is mounted directly to the catalyst 4. In other words,  
10 Applicant finds no objective evidence as to a cradle in which the catalyst 4 is held.

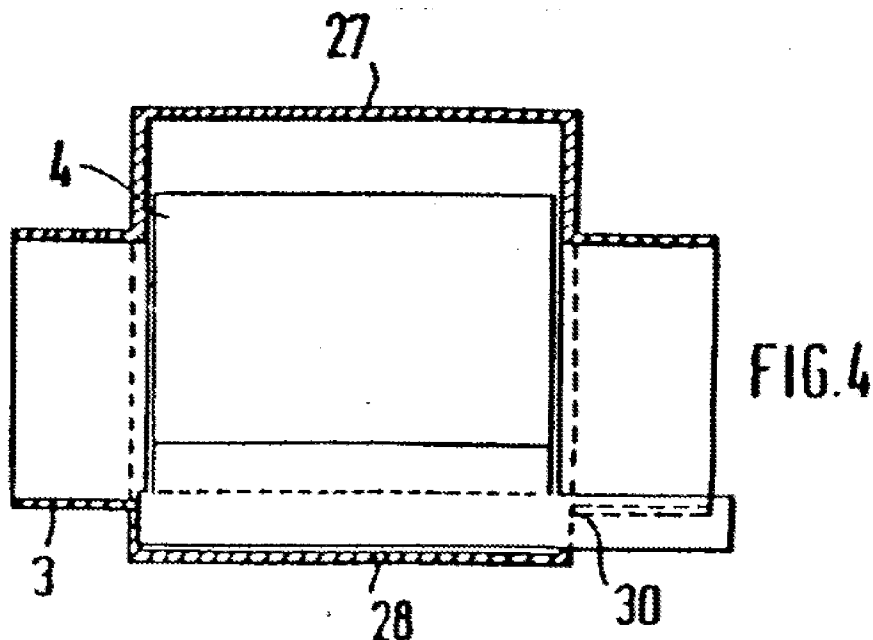


Fig. 4 is reproduced above, which shows the catalyst 4 configured “to be swiveled around a bearing point 30” (col. 2, lines 49-50). Again, Applicant finds no objective evidence as to a cradle in which the catalyst 4 is held.

5 *Pelters Reference: Hypothetical “Wall” or “Walls” do not disclose a Cradle*

Applicant understands that the Office must make the following assumptions (A, B and C) to find that a cradle is disclosed, which underlies the Office’s conclusion that claims 1-3 and 15-28 are properly rejected under § 102:

- A. Catalyst 4 of Fig. 2 is rectangular;
- 10 B. Catalyst 4 has a wall or walls; and
- C. The wall or walls are sufficient evidence of a cradle.

However, Applicant finds the objective evidence of record and logic insufficient to support these assumptions, especially assumption C. Specifically, even if a rectangular catalyst (assumption A) had a wall or walls (assumption B),  
15 Applicant submits that a wall or walls are not by themselves sufficient evidence of a cradle (assumption C).

As already mentioned, at col. 2, lines 15-17 the Pelters reference states that the catalyst 4 “may be round or rectangular”. Further, at col. 2, lines 36-40, the Pelters reference states: “Since in this moved-out position, the bottom 25 of the  
20 catalyst 4 covers the exhaust pipe 3 from above, no noticeable swirl is created in the exhaust gas flow and no resulting additional loss of pressure occurs.” One may therefore assume that this arrangement seems probable only if the catalyst 4 is rectangular (i.e., how could a cylinder cover the exhaust pipe 3 from above?).

Thus, assuming that the catalyst 4 is rectangular (assumption A), even if the  
25 bottom 25 of the catalyst 4 is considered to be a wall and even if the unnumbered top portion of the catalyst 4 is considered to be another wall (assumption B),  
Applicant submits that two walls alone do not make a cradle (assumption C).

Accordingly, the evidence in the Pelters reference is insufficient to find that a cradle is disclosed given the standards under § 102. Per Trintec: “The difference  
30 between a printer and a photocopier may be minimal and obvious to those of skill in

this art. Nevertheless, obviousness is not inherent anticipation.” Applicant contends that hypothetical walls or even actual walls do not make a cradle.

*Independent Claims 1 and 15*

5 Claims 1 and 15 each recite, in part:

*said catalyst body (1) is held by a cradle (5) having a plate (2, 3), and  
said active catalyst position (35) is provided in an exhaust passage the inner  
wall of which is in alignment with the plate (2, 3) when the catalyst body (1) is  
moved in its inactive catalyst position.*

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As discussed above, Applicant submits that the Pelters reference fails to provide sufficient evidence of a catalyst body held by a cradle having a plate. For at least this reason, Applicant submits that claims 1 and 15 are not anticipated by the Pelters reference.

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*Dependent Claim 2*

Dependent claim 2 recites: “*The variable position catalyst according to claim 1, wherein the plate (2, 3) is disc-shaped.*” A disc-shaped plate allows for a cylindrical catalyst chamber (see, e.g., Application, as filed, at page 7, second  
20 paragraph). Such subject matter is not disclosed by the Pelters reference. Specifically, claim 1 recites “a cradle (5) having a plate (2, 3)”. Hypothetically, even if a plate may be found, Applicant fails to find evidence of a cradle having such a plate.

25 *Dependent Claim 5*

Dependent claim 5 recites: “*The variable position catalyst according to claim 1, wherein the cradle (5) is connected to the actuator member (9) by an actuator rod (10).*” As the Pelters reference does not provide sufficient evidence of a cradle, the subject matter of claim 5 is not disclosed. Hypothetically, even if a plate may be  
30 found, Applicant fails to find evidence of a cradle having such a plate.

*Dependent Claim 6*

Dependent claim 6 recites: “*The variable position catalyst according to claim 5, wherein the catalyst housing (7) has a cylindrical inner shape and the cradle (5) has a cylindrical outer shape, the inner diameter of the catalyst housing (7) fitting to the outer diameter of the cradle (5).*” A disc-shaped plate allows for a cylindrical catalyst chamber (see, e.g., Application, as filed, at page 7, second paragraph). Such subject matter is not disclosed by the Pelters reference, especially given that claim 1 recites a cradle having a plate.

*Dependent Claim 7*

Dependent claim 7 recites: “*The variable position catalyst according to claim 5 or 6, wherein the cradle (5) comprises two disc-shaped plates (2, 3) between which the catalyst body (1) is held.*” Applicant fails to find evidence of such a cradle in the Pelters reference. In particular, even assuming two plates are disclosed, how would the catalyst be held?

*Dependent Claim 13*

Dependent claim 13 recites: “*The variable position catalyst according to claim 5, wherein the cradle (5) comprises a leading edge (13a) which is always in contact with a portion of the catalyst housing (7) providing the inactive position (14).*”

At col. 2, lines 34-36, the Pelters reference states: “The chamber 5 is constructed such that it can fully accommodate the catalyst 4 and surrounds it with a narrow gap 24.” Accordingly, the Pelters reference does not provide evidence of a cradle that includes a leading edge in contact with a portion of a catalyst housing.

*Dependent Claims 16, 19, 20, 21, and 27*

Applicant submits that the Pelters reference does not provide evidence sufficient to support an anticipation rejection of any of claims 16, 19, 20, 21, or 27, for at least some of the same reasons provided above.

*Dependent Claims 3, 4, 8-12, 17, 18, 22-26 and 28*

Applicant submits that dependent claims 3, 4, and 8-12 are not anticipated by the Pelters reference for at least the same reasons as claim 1. Applicant submits that dependent claims 17, 18, 22-26 and 28 are not anticipated by the Pelters  
5 reference for at least the same reasons as claim 15.

Rejections under 35 USC § 103(a)

In the pending Office Action, the Office rejects claims 14 and 29 under 35 USC § 103(a) as being unpatentable over Pelters et al. as applied to claims 1 and  
10 15, respectively, above.

*Standards*

Per MPEP § 2141.02: “the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention  
15 as a whole would have been obvious.” (emphasis in original)

Per MPEP § 2143.01: “A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient  
20 to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)”; and “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of  
25 obviousness.’ KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)”.

*Dependent Claims 14 and 29*

Dependent claim 14 recites: “*The variable position catalyst according to claim  
30 1, wherein the variable position catalyst is provided upstream of a turbocharger of an engine.*”



Dependent claim 29 recites: "*The combustion engine according to claim 15, further comprising a turbocharger for compressing the air to be supplied to the combustion engine, wherein the variable position catalyst is disposed upstream of the turbocharger.*"

5           Applicant submits that anticipation and obviousness are separate and distinct concepts. As particular reasons have not been articulated as to why claims 1 and 15 would be obvious over Pelters, Applicant respectfully refers to the reasons, above, as to why claims 1 and 15 are not anticipated by the Pelters reference. For at least these same reasons, Applicant submits that claims 14 and 29 are not  
10           unpatenable over the Pelters reference, noting that evidence of a cradle is lacking.

### Conclusion

          Claims 1-29 are pending and believed to be in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the present  
15           application. Should any issue remain that prevents immediate issuance of the application, the Examiner is encouraged to contact the undersigned attorney to discuss the unresolved issue.

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Respectfully Submitted,

Dated: May 22, 2011

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